

THIS OPINION IS NOT A
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Mailed: September 10, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re OxeFit, Inc.

Serial No. 90556063

Michael W. Dubner of Foley & Lardner LLP,
for OxeFit, Inc.

April Roach, Trademark Examining Attorney, Law Office 115,
Daniel Brody, Managing Attorney.

Before Pologeorgis, Allard, and Lavache,
Administrative Trademark Judges.

Opinion by Lavache, Administrative Trademark Judge:¹

¹ As part of an internal Board pilot program to broaden acceptable forms of legal citation in Board cases, citations in this opinion are in the form recommended in TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 101.03 (2024). This opinion cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals by the pages on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For opinions of the Board, this opinion uses citations to the Lexis legal database and cites only precedential decisions. Practitioners should also adhere to the practice set forth in TBMP § 101.03. Precedential decisions of the Board, and precedential decisions of the Federal Circuit involving Board decisions that issued January 1, 2008, or after may be viewed in TTABVUE by entering the proceeding number, application number, registration number, expungement/reexamination number, mark, party, or correspondent. Many precedential Board decisions that issued from 1996 to 2008 are available online from the TTAB Reading Room by entering the same information. Most TTAB decisions that issued prior to 1996 are not available in USPTO databases.

OxeFit, Inc. (“Applicant”) seeks registration on the Principal Register of the composite mark displayed below.²



The application identifies the following goods and services:

Downloadable software in the nature of an application for use by individuals participating in exercise classes, physical training, and exercise instruction for detecting, storing and reporting daily human energy expenditure and physical activity level, for developing and monitoring personal activity and exercise plans, and training goals, in International Class 9;

Exercise and fitness equipment, namely, upper and lower body cardiovascular conditioning machines and weight lifting machines, in International Class 28;

Streaming of audio and video materials on the Internet, namely, streaming of audio and video materials on the Internet featuring physical fitness classes, training, and instruction, in International Class 38;

Providing classes, workshops and seminars in the fields of fitness and exercise; physical fitness instruction and consultation; physical fitness conditioning classes; physical fitness training services; providing a website featuring information on exercise and physical fitness accessible through a global computer network and mobile devices; providing non-downloadable playback of audiovisual content featuring physical fitness classes, training and instruction via a global communications network, in International Class 41;

² Application Serial No. 90556063, filed on March 2, 2021, under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), based on an allegation of a bona fide intention to use the mark in commerce. The application includes the following description of the mark: “The mark consists of the letter X with two rightward facing chevrons on the left side of the X, the chevrons having an increasing thickness as they approach the letter X.” Color is not claimed as a feature of the mark.

Software as a service (SAAS) services featuring software for in analyzing, displaying, managing, recording, tracking, and visualizing bodily biometric, movement, physiological, and statistical data, goals, information, programs and metrics in the fields of exercise, physical fitness, health, and wellness; providing temporary use of non-downloadable computer application software for mobile devices, namely, software to assist the user with exercise, fitness, wellness and personal development, in International Class 42;³ and

On-line social networking services, in International Class 45.

The Trademark Examining Attorney refused registration of Applicant's mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground of likelihood of confusion, citing the composite mark below.⁴



The cited mark is registered on the Principal Register for “Downloadable computer software applications for analyzing, determining and developing customizable exercise programs for fitness training, weight loss, weight training, general well-being, and general health; Downloadable computer software applications for

³ The identification of Class 42 services appears to contain a typographical error in that it contains the word “in” in the phrase “Software as a service (SAAS) services featuring software for **in** analyzing” Although the inclusion of “in” is not grammatically ideal, it does not otherwise affect the nature of the identified services or our analysis.

⁴ Registration No. 6790117 issued on July 12, 2022. The registration contains the following description of the mark: “The mark consists of a chevron pointing to the right, placed on the left side of the letter ‘X.’” Color is not claimed as a feature of the mark.

analyzing fitness data and customizing an exercise program for an individual,” in International Class 9.

After the Examining Attorney issued a final refusal, Applicant appealed and requested reconsideration. The Examining Attorney denied the request for reconsideration, the appeal then resumed, and the case was fully briefed.

We affirm the Section 2(d) refusal to register for the reasons explained below.⁵

I. Likelihood of Confusion

Trademark Act Section 2(d), in relevant part, prohibits registration of a mark that “so resembles a mark registered in the Patent and Trademark Office . . . as to be likely, when used on or in connection with the goods of the applicant, to cause confusion.” 15 U.S.C. § 1052(d). To determine whether confusion is likely, we analyze all probative evidence relevant to the factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (“*DuPont*”). See *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315 (Fed. Cir. 2003).


In every Section 2(d) case, two key *DuPont* factors are the similarity or dissimilarity of the marks and the relatedness of the respective goods or services, because the “fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976). Here, we have considered each *DuPont* factor that is relevant and for

⁵ The TTABVue and Trademark Status and Document Retrieval (“TSDR”) citations in this opinion refer to the docket and electronic file database for the involved application.

which there is evidence and argument of record. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 1356 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 1205 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination.”). Ultimately, however, “each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 1199 (CCPA 1973).

A. Strength of the Cited Mark

Before we compare the marks, we consider the strength, as well as any weakness, of the cited mark  as used in connection with the goods identified in the cited registration. We do so because a determination of the strength or weakness of the mark helps inform us as to its scope of protection. *See In re Morinaga Nyugyo K.K.*, Ser. No. 86338392, 2016 TTAB LEXIS 448, at *17-18 (TTAB 2016) (“[T]he strength of the cited mark is—as always—relevant to assessing the likelihood of confusion under the *du Pont* framework.”).

When evaluating the strength or weakness of a mark, we look at the mark’s inherent strength based on the nature of the term itself and its commercial strength in the marketplace. *See Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 1362 (Fed. Cir. 2023) (“There are two prongs of analysis for a mark’s strength under the sixth factor: conceptual strength and commercial strength.”); *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1353-54 (Fed. Cir. 2010) (measuring both conceptual and marketplace

strength); *Made in Nature, LLC v. Pharmavite LLC*, Opp. No. 91223352, 2022 TTAB LEXIS 228, at *24 (TTAB 2022).

1. Conceptual Strength of the Cited Mark

Conceptual strength is a measure of a mark's distinctiveness and may be placed "in categories of generally increasing distinctiveness: . . . (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful." *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992).

Because the cited mark issued on the Principal Register, without a claim of acquired distinctiveness, the mark is presumed to be inherently distinctive for the goods listed in the cited registration. 15 U.S.C. § 1057(b); *Tea Bd. of India v. Republic of Tea, Inc.*, Opp. No. 9118587, 2006 TTAB LEXIS 330, at *62 (TTAB 2006) ("A mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the goods.").

The Federal Circuit has held, however, that if there is evidence that a mark, or an element of a mark, is commonly adopted by many different registrants, that may indicate that the mark or common element has some non-source-identifying significance that undermines its conceptual strength as an indicator of a single source. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1374 (Fed. Cir. 2015) ("[E]vidence of third-party registrations is relevant to 'show the sense in which a mark is used in ordinary parlance,' . . . that is, some segment that is common to both parties' marks may have

‘a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that segment is relatively weak.’”) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1339 (Fed. Cir. 2015)).

Here, Applicant argues that “the sheer number of other third-party registrations containing the ‘X’ designation in connection with fitness and/or sports equipment clearly demonstrates that the ‘X’ designation is so commonly used that the public will necessarily look to the other elements which Applicant believes are clearly distinctive.”⁶ In support, Applicant submitted third-party registrations for marks⁷ “containing the ‘X’ designation in connection with fitness and/or sports equipment.”⁸

Three of the 16 third-party registrations, namely, Registration Nos. 5557745, 6541587, and 6557334, were issued under § 66(a) of the Trademark Act (15 U.S.C. § 1141f(a)), and their records contain no § 71 affidavits or declarations of continuing use (15 U.S.C. § 1141k). Such registrations have very little, if any, persuasive value in this context because they do not demonstrate exposure of the mark through use in commerce prior to registration. *See In re Info. Builders Inc.*, Ser. No. 87753964, 2020 TTAB LEXIS 20, at *19 n.19 (TTAB 2020) (*citing Calypso Tech., Inc. v. Calypso Cap. Mgmt., LP*, Opp. No. 91184576, 2011 TTAB LEXIS 259, at *28 n.15 (TTAB 2011); *In re Princeton Tectonics, Inc.*, Ser. No. 77436425, 2010 TTAB LEXIS 224, at *8 (TTAB














⁶ Appeal Brief, 6 TTABVUE 12.

⁷ November 14, 2023 Request for Reconsideration at TSDR 11-31.

⁸ Appeal Brief, 6 TTABVUE 12. Applicant submitted a total of 16 third-party registrations during prosecution of the application, but specifically referenced only 13 of these registrations in its appeal brief. We have considered all of the registrations submitted and have reproduced the marks from all of the use-based registrations in this opinion.

2010)); *In re 1st USA Realty Prof'ls, Inc.*, Ser. No. 78553715, 2007 TTAB LEXIS 73, at *5-6 (TTAB 2007).

The marks in the remaining 13 third-party registrations are reproduced below.

Reg. No.	Mark	Reg. No.	Mark
4495085		5775756	
4602562		6139534	
4937434		6232330	
5424483		6969421	
5512918		7054067	
5943260		7176809	
6069166			

Aside from the common “X” element, almost all of these marks are dissimilar in commercial impression to the cited mark, because they feature different elements and stylizations. *See, e.g., Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d

669, 675 (Fed. Cir. 1984) (noting that none of third-party registrations submitted to show the number and nature of similar marks on similar goods had the same format or conveyed a similar commercial impression as the marks at issue). Six of the marks could be characterized as including chevron elements similar to those in the marks at issue here. But only the mark in Registration No. 5943260 comes close to conveying a similar commercial impression, as it features an “X” preceded by a right-facing chevron element. However, we agree with the Examining Attorney⁹ that this registration is of limited probative value here, because it is for “shirts” and the cited registration does not identify such goods. *See Omaha Steaks Int’l v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1324 (Fed. Cir. 2019) (“[T]he controlling inquiry is the extent of third-party marks in use on ‘similar’ goods or services.”).

Most of the remaining 12 third-party registrations concern physical fitness, and to that extent they are relevant.¹⁰ *See id.* These 12 third-party registrations suggest that the letter “X” may be commonly featured in marks associated with physical fitness and/or sporting goods and services.

However, none of these 12 third-party registrations incorporate the unique stylization of the cited mark and, as a result, none are as similar to the cited mark as

⁹ Examining Attorney’s Brief, 8 TTABVUE 6.

¹⁰ Some of these registrations are less relevant or probative in terms of their listed goods. For instance, Registration No. 6557334 does reference instruments and apparatus for physical exercise, but the specific goods are electronic components for such instruments and apparatus. And Registration No. 4495085 lists stretching devices for physical therapy. These goods are markedly different than the exercise/fitness equipment in Applicant’s application. However, we do not delve further into this issue, because we find the marks themselves to be dissimilar to Registrant’s mark in terms of commercial impression.

the applied-for mark. Specifically, none use a chevron element to create a stacked “X” appearance. Rather, each registration consists of marks with entirely different stylizations of the letter “X” with a completely different connotation and commercial impression. *See Sabhnani v. Mirage Brands, LLC*, Canc. No. 92068086, 2021 TTAB LEXIS 464, at *32 (TTAB 2021) (“[W]hile the registered marks all contain the word ‘MIRAGE,’ they contain additional elements that cause many of them to be less similar to Petitioner’s mark than Respondent’s marks are.”). Third-party marks must generally be as similar to the registered mark as the applied-for mark. *See, e.g., Specialty Brands*, 748 F.2d at 675 (“Applicant introduced evidence of eight third-party registrations for tea which contain the word ‘SPICE’, five of which are shown to be in use. None of these marks has a ‘SPICE (place)’ format or conveys a commercial impression similar to that projected by the SPICE ISLANDS mark, and these third-party registrations are of significantly greater difference from SPICE VALLEY and SPICE ISLANDS than either of these two marks from each other.”). We therefore find that, while the letter “X” standing alone in the cited mark is somewhat conceptually weak, the third-party registration evidence does not show that the mark as a whole has been conceptually weakened.

2. Commercial Strength of the Cited Mark

a. Fame – Fifth *DuPont* Factor

The fifth *DuPont* factor examines the extent to which the public perceives the mark as indicating a single source of origin, i.e., its fame or commercial strength. *DuPont*, 476 F.2d at 1361. However, as is typical in an ex parte proceeding, the record in this case provides no basis for a finding that the cited mark is commercially strong

when used in association with Registrant's goods. "[I]n an ex parte appeal the 'fame of the mark' factor is normally treated as neutral because the record generally includes no evidence as to fame." *In re Mr. Recipe, LLC*, Ser. No. 86040643, 2016 TTAB LEXIS 80, at *4 (TTAB 2016) (citing *In re Thomas*, Ser. No. 78334625, 2006 TTAB LEXIS 135, at *18 n.11 (TTAB 2006)).

Thus, the fifth *DuPont* factor is neutral.

b. Similar Marks on Similar Goods – Sixth *DuPont* Factor

We next address the sixth *DuPont* factor, the number and nature of similar marks in use on similar goods and services. *DuPont*, 476 F.2d at 1361; see *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, Opp. No. 91217095, 2016 TTAB LEXIS 604, at *11 (TTAB 2016). The Federal Circuit has held that evidence of extensive registration and use of a term by others for similar goods or services can be "powerful" evidence of the term's weakness. *Jack Wolfskin*, 797 F.3d at 1373-74; *Juice Generation*, 794 F.3d at 1339. If the evidence establishes that the consuming public is exposed to widespread third-party use of similar marks for similar goods or services, it "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1373 (Fed. Cir. 2005).

Applicant has not submitted any evidence concerning third-party marketplace uses of marks identical or similar to the cited mark for goods identical or similar to those listed in the cited registration. And, as previously noted, the third-party registration evidence submitted by Applicant is insufficient to justify narrowing the scope of protection afforded the cited mark.

As a result, Applicant has not established that the cited mark as a whole has been weakened by third-party registrations or marketplace uses of similar marks. That said, the cited mark's strength is somewhat limited by use of the letter "X," which has been shown to be somewhat conceptually and commercially weak by third-party registration evidence. The sixth *DuPont* factor therefore weighs slightly against a likelihood of confusion based on the partial conceptual and commercial weakness of the cited mark.

B. Comparison of the Marks

We turn next to the first *DuPont* factor, which focuses on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imps.* 396 F.3d at 1371 (quoting *DuPont*, 476 F.2d at 1361). Similarity as to any one of these elements may be sufficient to support a finding that the marks are confusingly similar. *See Krim-Ko Corp. v. Coca-Cola Co.*, 390 F.2d 728, 732 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion."); *In re Inn at St. John's, LLC*, Ser. No. 87075988, 2018 TTAB LEXIS 170, at *13 (TTAB 2018).

All elements of the respective marks must be considered. *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985). However, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *Id.*

The marks at issue here are reproduced below.



Applicant's Mark



Cited Mark

While we have displayed the respective marks next to each other for purposes of our analysis, such placement does not reflect the actual conditions under which consumers are likely to encounter the marks in the marketplace. That is, “[t]he proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *In re i.am.symbolic*, 866 F.3d 1315, 1324 (Fed. Cir. 2017) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012) (internal quotation marks omitted)). And, importantly, “[t]he focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks.” *In re Box Sols. Corp.*, Ser. No. 76267086, 2006 TTAB LEXIS 176, at *14 (TTAB 2006).

In this case, both Applicant’s mark and the cited mark consist of the letter “X” preceded by at least one chevron element creating a negative space or “stacked X” effect. The most significant differences between the two marks are the number of chevron elements and those elements’ relative thickness, i.e., font weight. The cited mark has one chevron that appears to be of equal font weight to the “X” element. Applicant’s mark, on the other hand, features two chevrons, with “the thickness of

the left-most chevron [being] half the size of the right chevron, which is half of the thickness of the X.”¹¹ Applicant also asserts that “the respective fonts [of the marks] are different, which creates different commercial impressions.”¹²

Applicant disputes the Examining Attorney’s characterization of these differences as minor, and asserts that it is these “differences that create a different overall commercial impression to the consumer.”¹³ Specifically, Applicant argues that, in its mark, the “difference of incorporating multiple chevrons intentionally creates a distinct stacked ‘X’ appearance.”¹⁴ Additionally, Applicant claims that the varying thickness of the chevron elements “suggests progression or growth as Applicant’s Mark is intended to evoke an increase in stamina and/or strength,” whereas the cited mark is “less suggestive of movement, progression of any kind.”¹⁵ Elaborating further, Applicant states that its mark “portrays and/or otherwise depicts a chronophotographic image where layered portions of the object create the visual imagery of movement, intentionally evoking body/machine synchronous movement associated with Applicant’s exercise equipment.”¹⁶

Applicant’s arguments regarding the differences between the marks rely heavily on Applicant’s intentions as to the meaning to be conveyed by its mark, as opposed to

¹¹ Appeal Brief, 6 TTABVUE 10.

¹² *Id.* at 11.

¹³ *Id.* at 10.

¹⁴ *Id.*

¹⁵ *Id.*

¹⁶ *Id.*

what the likely consumer perception might be. Although we have no reason to doubt Applicant's claimed intent to evoke through its mark an "increase in stamina and/or strength" or a "body/machine synchronous movement associated with Applicant's exercise equipment," we are not convinced that consumers will necessarily view Applicant's mark specifically as it intends. And, in assessing similarity, we must consider only the marks before us, regardless of what Applicant may intend to convey through its mark. *See, e.g., B.V.D. Licensing Corp. v. Rodriguez*, Opp. No. 91157529, 2007 TTAB LEXIS 32 (TTAB 2007) ("[W]e assess the connotation of applicant's mark from the perspective that consumers will see only that which applicant seeks to register."); *Blue Cross & Blue Shield Ass'n v. Harvard Cmty. Health Plan, Inc.*, Opp. No. 91078270, 1990 TTAB LEXIS 43, at *3-6 (TTAB 1990) (rejecting applicant's arguments as to its intent in adopting the elements of its mark, in view of the possible consumer perception of the mark); *cf. i.am.symbolic*, Ser. No. 85044494, 2015 TTAB LEXIS 369, at *14-16 (TTAB 2015) (finding that applicant's and registrant's identical marks would be perceived similarly despite applicant's intentions to promote its mark in connection with a famed music artist).

Here, we are not persuaded that the differences between the respective marks are so significant that they would result in such different commercial impressions so as to preclude consumer confusion. *See, e.g., In re Charger Ventures*, 64 F.4th 1375, 1382 (Fed. Cir. 2023) ("[A]n additional word or component may technically differentiate a mark but do little to alleviate confusion."); *In re Peace Love World Live, LLC*, Ser. No. 86705287, 2018 TTAB LEXIS 220, at *23 (TTAB 2018) ("Slight differences in marks

do not normally create dissimilar marks.”). Because both marks are composed of the same elements—an “X” preceded by at least one right-facing chevron—they are highly similar in appearance. In addition, to the extent the marks are pronounced at all by consumers, they are likely to be pronounced the same, namely, as one would pronounce “X.”

Accordingly, any likely connotation or commercial impression associated with Applicant’s mark may just as likely be associated with the cited mark. So, both marks here could be perceived as evoking an “increase in stamina and/or strength” or a “body/machine synchronous movement associated with . . . exercise equipment.” Likewise, both marks could be perceived as having a “stacked X” effect. And the slight differences in the number of chevrons, their font weight, or the font types used, are likely to have minimal impact on a consumer’s ability to distinguish the marks, given that consumers encountering either of the marks in the marketplace will not have the benefit of a careful analysis aided by a side-by-side comparison. *See Grandpa Pidgeon’s of Mo., Inc. v. Borgsmiller*, 477 F.2d 586, 587 (CCPA 1973) (noting the difference in the respective marks’ depiction of an elderly man was “a difference not likely to be recalled by purchasers seeing the marks at spaced intervals”); *Info. Builders*, 2020 TTAB LEXIS 20, at *21 (“[I]n the normal environment of the marketplace where purchases are actually made, purchasers and prospective purchasers would not usually have the opportunity for a careful examination of these marks in minute detail, even if such consumers are sophisticated.”); *In re QVC*, Ser. No. 75547477, 2003 TTAB LEXIS 687, at *7 (TTAB 2003) (“[I]t is the similarity of the

general overall commercial impression engendered by the marks that must be considered.”).

We therefore find that, while there are minor differences between the marks, in their entireties they are highly similar in sound, appearance, connotation, and overall commercial impression.

Thus, the first *DuPont* factor weighs strongly in favor of a finding of likelihood of confusion.

C. Relatedness of the Goods and Services

The second *DuPont* factor focuses on the similarity or dissimilarity and nature of the respective goods and services. *DuPont*, 476 F.2d at 1361. In determining the relatedness of the goods and services, we must look to the goods and services as identified in Applicant’s application and the cited registration. *See Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 1323 (Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 942 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods [or services], the particular channels of trade or the class of purchasers to which the sales of goods [or services] are directed.”)).

It is sufficient that the goods or services are related in some manner, or that the conditions and activities surrounding their marketing are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from

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the same source. *See Coach Servs. Inc.*, 668 F.3d at 1396; *7-Eleven, Inc. v. Wechsler*, Opp. No. 91117739, 2007 TTAB LEXIS 58, at *18 (TTAB 2007). The issue is not whether consumers would confuse Applicant's goods or services with Registrant's goods, but rather whether there is a likelihood of confusion as to their source. *L'Oreal S.A. v. Marcon*, Opp. No. 91184456, 2012 TTAB LEXIS 77, at *16 (TTAB 2012); *In re Rexel Inc.*, Ser. No. 73241423, 1984 TTAB LEXIS 57, at *2 (TTAB 1984).

Registration may be refused as to a particular class of goods or services if Applicant's mark for any of its identified goods or services in that class is likely to cause confusion with Registrant's mark for any of the goods listed in the cited registration. *See SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 1041 (Fed. Cir. 1983) (holding that a single good from among several may sustain a finding of likelihood of confusion); *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 1336 (CCPA 1981) (indicating that likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods or services in the application).

In the present case, Applicant's goods and services are identified as follows:

Downloadable software in the nature of an application for use by individuals participating in exercise classes, physical training, and exercise instruction for detecting, storing and reporting daily human energy expenditure and physical activity level, for developing and monitoring personal activity and exercise plans, and training goals, in International Class 9;

Exercise and fitness equipment, namely, upper and lower body cardiovascular conditioning machines and weight lifting machines, in International Class 28;

Streaming of audio and video materials on the Internet, namely, streaming of audio and video materials on the Internet featuring physical fitness classes, training, and instruction, in International Class 38;

Providing classes, workshops and seminars in the fields of fitness and exercise; physical fitness instruction and consultation; physical fitness conditioning classes; physical fitness training services; providing a website featuring information on exercise and physical fitness accessible through a global computer network and mobile devices; providing non-downloadable playback of audiovisual content featuring physical fitness classes, training and instruction via a global communications network, in International Class 41;

Software as a service (SAAS) services featuring software for in analyzing, displaying, managing, recording, tracking, and visualizing bodily biometric, movement, physiological, and statistical data, goals, information, programs and metrics in the fields of exercise, physical fitness, health, and wellness; providing temporary use of non-downloadable computer application software for mobile devices, namely, software to assist the user with exercise, fitness, wellness and personal development, in International Class 42; and

On-line social networking services, in International Class 45.

Registrant's goods are "Downloadable computer software applications for analyzing, determining and developing customizable exercise programs for fitness training, weight loss, weight training, general well-being, and general health; Downloadable computer software applications for analyzing fitness data and customizing an exercise program for an individual," in International Class 9.

Turning to our analysis, we find that Applicant's identified Class 9 goods are legally identical in part to Registrant's Class 9 goods. Both consist of software that, inter alia, allows the user to develop an exercise program or plan. In addition, some of the wording used to identify Registrant's software is broad enough to encompass Applicant's software. For example, the functions of Registrant's software include

“analyzing fitness data,” which could involve Applicant’s software’s functions of “detecting, storing, and reporting daily human energy expenditure and physical activity level.” And, while Applicant’s Class 9 goods are identified as intended “for use by individuals participating in exercise classes, physical training, and exercise instruction,” Registrant’s goods contain no such limitation and thus could include software for use by the same types of users. *See, e.g., In re Solid State Design, Inc.*, Ser. No. 87269041, 2018 TTAB LEXIS 1, at *15-16 (TTAB 2018) (“[W]here the goods in an application or registration are broadly described, they are deemed to encompass ‘all the goods of the nature and type described therein.’” (quoting *In re Jump Designs, LLC*, Ser. No. 76393986, 2006 TTAB LEXIS 209, at *13 (TTAB 2006), *overruled on other grounds by In re Driven Innovations, Inc.*, Ser. No. 77073701, 2015 TTAB LEXIS 179, at *13 (TTAB 2015))).

Similarly, as the Examining Attorney notes,¹⁷ Applicant’s Class 42 services feature software that “assist[s] the user with exercise, fitness, wellness, and personal development,” which is broad enough to encompass Registrant’s Class 9 software’s functions of “analyzing, determining and developing customizable exercise programs for fitness training, weight loss, weight training, general well-being, and general health.” Likewise, Registrant’s Class 9 software is used “for analyzing fitness data and customizing an exercise program for an individual,” which could encompass the following functions of the software provided via Applicant’s Class 42 services: “analyzing . . . bodily biometric, movement, physiological, and statistical data, goals,

¹⁷ Examining Attorney’s Brief, 8 TTABVUE 7.

information, programs and metrics in the fields of exercise, physical fitness, health, and wellness.”¹⁸

Applicant does not dispute that the respective Class 9 goods are legally identical in part, or that its Class 42 services feature software that is identical in function to Registrant’s goods. Nor does Applicant otherwise offer any arguments about the similarity or dissimilarity and nature of the other goods and services at issue here.

As to the other goods and services, evidence showing that third parties in the marketplace offer the respective goods and services under a single mark may support the conclusion that consumers will view the goods and services as related. *See, e.g., Naterra Int’l, Inc. v. Bensalem*, 92 F.4th 1113, 1117 (Fed. Cir. 2024) (“[T]estimony that third-party companies sell both types of goods is pertinent to the relatedness of the goods.”); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1328-29 (Fed. Cir. 2000) (finding the Board “erred when it refused to consider the lay evidence that several large companies produce and sell both pet and human food in deciding whether a consumer would reasonably believe that . . . dog treats originated from the same source as . . . human snacks”).

To that end, the Examining Attorney has submitted third-party website excerpts showing that it is not uncommon for a single entity to offer fitness software along with one or more of the following goods or services: exercise/fitness equipment, fitness instruction, Internet streaming of audio-visual content in the field of fitness instruction, and online social networking.

¹⁸ *See id.* at 7-8.

For example:

- Tonal (www.tonal.com) offers software for fitness instruction, planning, and tracking; fitness equipment for strength training; online fitness instruction; streaming of audio-visual content featuring fitness instruction; and online social networking services;¹⁹
- Forme (www.formelife.com) offers software for fitness instruction, tracking, and planning; online fitness instruction; streaming of audio-visual content featuring fitness instruction; and fitness equipment for strength training;²⁰
- JEFIT (www.jefit.com) offers software for fitness instruction, tracking and planning; online fitness instruction; streaming of audio-visual content featuring fitness instruction; and online social networking services;²¹
- MAXPRO (www.maxprofitness.com) offers fitness tracking and planning software; online fitness instruction; fitness equipment for cardiovascular and strength training; streaming of audio-visual content featuring fitness instruction; and online social networking services;²²
- iFIT (www.ifit.com) offers fitness tracking and planning software; online fitness instruction; fitness equipment for cardiovascular and strength

¹⁹ November 27, 2022 Office Action at TSDR 9-33.

²⁰ *Id.* at 34-83.

²¹ *Id.* at 84-97.

²² *Id.* at 98-121.

training; and streaming of audio-visual content featuring fitness instruction;²³

- LifeFitness (www.lifefitness.com) offers fitness tracking software; online fitness instruction; fitness equipment for cardiovascular and strength training; and streaming of audio-visual content featuring fitness instruction;²⁴
- Hoist Fitness (www.hoistfitness.com) offers software for fitness instruction, planning, and tracking; online fitness instruction; streaming of audio-visual content featuring fitness instruction; and fitness equipment for strength and cardiovascular training;²⁵
- Vitruvian Form (www.vitruvianform.com) offers software for fitness instruction, planning, and tracking; fitness equipment for cardiovascular and strength training; online fitness instruction; streaming of audio-visual content featuring fitness instruction, and social networking;²⁶
- Speediance (www.speediance.com) offers software for fitness instruction, planning, and tracking; fitness equipment for cardiovascular and strength training; online fitness instruction; and streaming of audio-visual content featuring fitness instruction;²⁷ and

²³ December 12, 2023 Denial of Request for Reconsideration at TSDR 55-109.

²⁴ *Id.* at 111-142.

²⁵ *Id.* at 143-151.

²⁶ *Id.* at 152-183.

²⁷ *Id.* at 184-215.

- Bowflex (www.bowflex.com) offers software for fitness instruction, planning, and tracking; online fitness instruction; fitness equipment for cardiovascular and strength training; and streaming of audio-visual content featuring fitness instruction.²⁸

Based on the Examining Attorney's third-party website evidence, we conclude that consumers are accustomed to encountering both Applicant's goods and services and Registrant's goods being offered either separately or together by the same source under the same mark. This evidence also indicates that fitness software, fitness equipment, and fitness instruction, and social networking are complementary goods and services, in that they are used together by individuals engaged in exercise. *See In re Ox Paperboard, LLC*, Ser. No. 87847482, 2020 TTAB LEXIS 266, at *18 (TTAB 2020) (noting that complementary use of goods is a factor in finding relatedness). For example, an individual may use a fitness app to develop a fitness plan, receive instruction on a fitness workout, and watch a video to learn how to do an exercise, then use fitness equipment to perform the exercise while tracking fitness stats generated by the exercise, and later share that information through social networking means with a trainer or friends.

To summarize, Applicant's Class 9 goods are legally identical in part to Registrant's goods. In addition, Applicant's Class 42 services feature software that is identical in function to Registrant's goods. We therefore find Applicant's Class 42 services and Registrant's goods related. We also find the evidence of record is

²⁸ *Id.* at 216-239.

sufficient to establish that Applicant's remaining goods and services are closely related to Registrant's goods, such that they would be encountered by the same persons under circumstances that could give rise to the mistaken belief that they originate from the same source if offered under confusingly similar marks.

Accordingly, the second *DuPont* factor weighs strongly in favor of a finding of likelihood of confusion.

D. Similarity of the Trade Channels

We next consider established, likely-to-continue channels of trade, the third *DuPont* factor. Because Applicant's Class 9 goods and Registrant's goods are legally identical in part, we must presume these legally identical goods travel through the same channels of trade and are offered to the same or overlapping classes of purchasers. *In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012) (finding Board is entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 754 (CCPA 1968) (noting that where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same).

Applicant's remaining goods and services have no restrictions as to channels of trade or classes of customers, nor do Registrant's goods. Accordingly, we must presume that the identifications encompass all goods and services of the type described, that the goods and services travel through all normal channels of trade for such goods and services, and that they are available to all classes of purchasers of such goods and services. *See Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*,

719 F.3d 1367, 1373 (Fed. Cir. 2013); *Univ. of Ky. v. 40-0, LLC*, Opp. No. 91224310, 2021 TTAB LEXIS 68, at *32-33 (TTAB 2021) (“Because there are no limitations on the channels of trade or classes of consumers of the . . . [goods] identified in the application, the relevant consuming public comprises all potential purchasers of . . . [such goods].”).

We find that the Examining Attorney’s third-party website evidence shows that Applicant’s goods and services, and Registrant’s goods, at a minimum, travel in some of the same or overlapping channels of trade and are offered to overlapping consumers.²⁹

Thus, the third *DuPont* factor weighs in favor of a finding of likelihood of confusion.

E. Applicant’s Intent in Adopting its Mark

Applicant argues that another factor to consider in the likelihood of confusion analysis is Applicant’s intent in adopting the applied-for mark.³⁰ This factor is typically relevant in inter partes proceedings where there is evidence that a party acted in bad faith in adopting its mark. *See, e.g., QuikTrip W., Inc. v. Weigel Stores,*

²⁹ We acknowledge that the Internet is a pervasive medium—so much so that “the mere fact that goods and services may both be advertised and offered through the Internet is not a sufficient basis to find that they are sold through the same channels of trade.” *Parfums de Couer Ltd. v. Lazarus*, Opp. No. 91161331, 2007 TTAB LEXIS 36, at *31-32 (TTAB 2007). But Internet evidence of the same retailers offering the same goods and services for sale under the same marks, as is the case here, is relevant evidence demonstrating that the goods and services can be encountered in overlapping channels of trade. *See In re I-Coat Co.*, Ser. No. 86802467, 2018 TTAB LEXIS 171, at *27 (TTAB 2018) (accepting third-party Internet website evidence showing applicant’s and registrant’s goods offered by same businesses under same marks as evidence of a common channel of trade).

³⁰ Appeal Brief, 6 TTABVUE 19.

Inc., 984 F.3d 1031, 1036 (Fed. Cir. 2021); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1462 (Fed. Cir. 1991) (“Whether there is evidence of intent to trade on the goodwill of another is a factor to be considered.”); *Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 853 F.2d 888, 891 (Fed. Cir. 1988) (noting that “proof of intent to trade on another’s goodwill” can provide “persuasive evidence of likelihood of confusion”).

In this case, as Applicant itself notes, the Examining Attorney has “not contended that Applicant adopted its mark with any intent to trade upon any goodwill or reputation of the cited registrant.”³¹ Thus, as is usually the case in ex parte appeals of Section 2(d) refusals, Applicant’s intent in adopting its mark is not at issue here.

In any event, good-faith adoption of a mark that is similar to a prior registered mark, for use on the same or similar goods, does not preclude confusion. *See Miles Labs. Inc. v. Naturally Vitamin Supplements Inc.*, Opp. No. 91062820, 1986 TTAB LEXIS 173, at *22 (TTAB 1986) (“[A]pplicant is not in any case absolved from the duty imposed by our trademark law on all late-comers to select marks for their new products that are sufficiently distinguishable from marks in respect of which others have federally recorded superior rights to prevent confusion.”). Thus, “[w]hile evidence of bad faith adoption typically will weigh against an applicant, good faith adoption typically does not aid an applicant attempting to establish no likelihood of confusion.” *Monster Energy Co. v. Lo*, Opp. No. 91225050, 2023 TTAB LEXIS 14, at *70 (TTAB 2023) (citing *J & J Snack Foods*, 932 F.2d at 1461).

³¹ *Id.*

Accordingly, we find this factor is neutral.

F. Extent of Potential Confusion

Lastly, Applicant indicates that we must consider “the extent of any potential confusion, i.e., whether de minimus [sic] or substantial,”³² which is the twelfth *DuPont* factor. Applicant argues that, “[b]ecause of the differences in the appearance and commercial impression between the marks” any likelihood of confusion here is de minimis, which “therefore independently mitigates against a finding of likelihood of confusion.”³³

This argument is unavailing. The marks here are highly similar and Applicant’s goods and services are legally identical in part, and otherwise closely related, to Registrant’s goods. Moreover, the evidence of record indicates that the relevant goods and services are of a type offered by many parties in the marketplace, and are likely to be marketed to and purchased by significant numbers of consumers. Thus, the extent of potential confusion cannot reasonably be deemed to be de minimis. *See, e.g., In re Davey Prods. Pty*, Ser. No. 77029776, 2009 TTAB LEXIS 524, at *26 (TTAB 2009) (rejecting applicant’s argument that the potential for confusion was de minimis where the goods at issue “would be marketed to and purchased by significant numbers of purchasers”).


This factor is, at best, neutral.

³² Appeal Brief, 6 TTABVUE 18.

³³ *Id.*

II. Balancing the Factors

Having carefully considered all of the arguments and evidence of record and all relevant *DuPont* factors, we find that (1) the marks at issue are highly similar, (2) Applicant's goods and services and Registrant's goods are legally identical in part and otherwise closely related, (3) Applicant's goods and services and Registrant's goods travel in overlapping trade channels and are offered to overlapping classes of purchasers, (4) the fifth factor, relating to fame of the cited mark, is neutral, (5) the sixth factor weighs slightly against a likelihood of confusion because the cited mark's strength is somewhat limited by use of the letter "X," which the record suggests is conceptually and commercially weak, (6) Applicant's purported good-faith intent in adopting the mark does not preclude confusion, and (7) the extent of potential confusion is more than merely de minimis. Balancing these factors, we conclude that the first, second, and third *DuPont* factors outweigh the sixth *DuPont* factor and, therefore, confusion as to source is likely.

Decision: The refusal to register Applicant's  mark under Section 2(d) of the Trademark Act is affirmed.